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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,556	06/13/2001	Harold Brodie	S1011	9517

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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 07/21/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

A 814

Office Action Summary

Application No.

09/880,556

Applicant(s)

BRODIE ET AL.

Examiner

Anthony J. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003 and 07 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this reissue application after final rejection. Since this reissue application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 March 2003 has been entered.
2. The affidavits and declarations submitted on 07 April 2003 have been received and made of record.
3. Based on applicant's amendments and affidavits, the previously made art rejections have been overcome.

Oath/Declaration

4. The reissue declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

(a) it does accurately reflect the status of the claims. The declaration states that claims 30-32 have been withdrawn without prejudice. This is incorrect because claims 31-32 have been canceled by the preliminary amendment (and a canceled claim is different than a withdrawn claim) and because there is no amendment specifically canceling claim 30.

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5. Claims 1-30 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defects in the declaration is set forth in the discussion above in this Office action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 12-13 and 17-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No literal support can be found in the specification for all of the recited subject matter.

8. Claims 12-13 and 17-32 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

In claim 12 applicant recites "resin based powder" which is broader than that of the disclosure as the disclosure requires that the powder be a polymer powder. Applicant argues that

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the phrase is taught by the disclosure as the disclosure discloses resin based powders. It is the position of the examiner that support lacks for the broad term "resin based" as this encompasses both natural and synthetic resins and natural resins do not appear to be contemplated by the reference based on the types of polymers taught by the disclosure.

In claims 13 and 17 the term "acrylate" is broader than the original disclosure as the original disclosure recited "acrylic". Since "acrylic" is an example of an "acrylate" the scope is broader than the original disclosure.

The method of claims 17-18 is broader than that of the original disclosure as the original disclosure requires that the powder coating produced be one that produces a composition comprising particles each of which is a polymer powder and each of which contain an organic biocide. These claims lack this essential feature. Also essential steps appear to be missing from claim 18 as the single step of mixing the agent into precursors does not in itself produce the coating composition.

In claims 21-23 and 25-25 the types and amounts of the biocides are not supported by the specification as originally filed. Applicant argues that since the reference teaches that "Many biocides may be suitably employed in the invention and the average skilled man of the art would readily be able to determine by routine experimentation whether the biocidal activity of any particular biocide will be sufficiently retained form his particular needs in the coating". It is the position of the examiner that the types found in the claims are not obvious from the disclosure as the particularly claimed types and amounts cannot be readily implied from the disclosure. That is,

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the particular types and amounts would require undue experimentation. Applicant appears to be using "hind-sight" which is improper. Applicant also argues and presents an affidavit showing that the types of biocides are well known in the art. While this may be true it is the position of the examiner that the applicant is using hind-sight as there is nothing in the specification that would lead one to use those biocides now being claimed and applicant has not provided any convincing evidence to that effect. Note that the specification lists suitable classes of biocides that may be listed and note that none of those now recited in the claims fall within the suitable classes. It is the position that if the newly added biocides were members of the classes taught by the reference, then their addition would not be considered to be new matter. Accordingly their addition to the claims is considered new matter. As for the amounts, while applicant argues that the specification recites that the biocide is present in an amount of 0.1-20 wt%, it is the position of the examiner that the recitation of "greater than 1 weight percent" and "greater than 5 weight percent" is not properly supported by the specification as the claim is broader than the specification as no upper limit is recited. Note that the upper limit for the biocide is 20%. The phrase "greater than 1 wt%" has a scope that is broader as this phrase allows for amounts outside the upper limit of 20%.

In claim 28 applicant recites a temperature for baking the thermoplastic polymer however this is not supported by the specification. Applicant argues that "it is obvious to the skilled worker in this field that the baking temperature should be adjusted accordingly when using thermoplastic polymer powders in place of thermosetting polymers, therefore this feature is

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implicit supported by the disclosure. It is the position of the examiner that this is not implicitly supported by the reference as the reference provides no guidance as to baking thermoplastic polymer powders. The temperature range recited in the specification for the thermosetting powders is for curing the thermosetting powders as the "stoving temperature" is the curing temperature. Since thermoplastic polymers are not cured like thermosetting polymers, it is the position of the examiner that the claim is not supported by the specification as the instant specification is concerned with "curing" and not "baking". Again applicant appears to be using "hind-sight" which is improper.

In claim 29 applicant recites the use of a pre-mixer, and that the mixtures is melted and cooled which is not taught by the original disclosure. With respect to the pre-mixer, applicant argues that it would be obvious to a skilled worker in this field that a pre-mixer could be used to carry out this step". It is the position of the examiner that it cannot be readily implied from the disclosure to use a pre-mixer. Applicant has not provided any evidence that this would be obvious to one of ordinary skill in the art. Also the step of melting and cooling cannot be readily implied by one of ordinary skill in the art by the teachings of the disclosure. Applicant admits that there is no disclosure of heating the mixture to a temperature high enough to melt it, or cooling and that they "may be obvious" to the skilled worker however applicant has not provided any evidence showing this. Again applicant appears to be using "hind-sight" which is improper.

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In claim 30 no support can be seen for the use of a solid support material. It is noted that applicants recite in the declaration that this claim has been withdrawn which is not the case as no amendment to “withdraw” the claim has been submitted.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 12-14 and 17-27 and 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12 it is unclear as to the types of resin based powders encompassed by the claim. Applicant's attention is drawn to Item #8 for reasons as to why the types are unclear.

In claim 17 the phrase “the resin based powder” lacks proper antecedent basis. Also it appears that the recited resins are thermosetting resins and not thermoplastic resins. Accordingly it appears that no thermoplastic resin is recited in the claim.

In claim 29 the phrase “the polymer precursors” is inconsistent with the terminology found in claim 18 as claim 18 refers to “precursors of a polymer powder”. Applicant needs to use consistent terminology.

In claim 30 the phrase “the coating pre-mix” lacks proper antecedent basis.

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11. Claims 12-14 and 17-32 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the parent application applicant amended the claims to recite (1) that the polymer powder is a thermosetting polymer, (2) that the biocide is organic in nature and (3) that the composition is in the form of particulates each comprising the polymer powder containing the biocide in order to overcome the art rejections and accordingly since all these limitations are not present in independent claims 12, 17-18 and 28 it appears that applicant is attempting to recapture subject matter surrendered in the parent application. Applicant's attention is drawn to the pages 4-5 of the response filed on 21 May 1999 in the parent application wherein applicant argues that the insertion of these limitations overcomes the art rejections. Applicant argues that this is not the case as the amendment were made merely for clarification. It is the examiner's position

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that the amendments were made to overcome the art rejections and therefore the broader scope was surrendered.

Double Patenting

12. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

13. Claim 28 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 13 of prior U.S. Patent No. 6,129,782. This is a double patenting rejection.

Applicant's have not provided any arguments concerning this rejection and accordingly it is repeated.

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14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,129,782. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to claims of the prior patent would render obvious the instant claims.

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Claim 11 of the prior patent is encompassed by the instant claim 17 as instant claim 17 is broad enough to encompass the claim. Claim 17 relates to a method using thermosetting and/or thermoplastic resins whereas claim 11 of the prior patent relates to just thermoplastic resins.

Claim Objections

16. Claims 14, 17 and 29 are objected to because of the following informalities:

In claim 14, line 1, the term "ore" should be -- or --.

In claim 17, line 8, the term "homogenously" should be -- homogeneously --.

In claim 29, line 2, the term "precurosors" should be -- precursors --.

Appropriate correction is required.

Request To Provoke Interference

17. Applicant's request to provoke an interference is acknowledged however it should be noted that no interference can be declared until there is at least one allowable claim which corresponds to a proposed count of the interference.

Surrender Of Original Patent

18. Applicant is reminded that the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Green whose telephone number is (703) 308-3819. The examiner can normally be reached on Monday - Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone numbers for the Group are as follows:

- (i) (703) 872-9310 for any non-final amendment or communication, and
- (ii) (703) 872-9311 for any after-final amendment or communication.

It is suggested that the examiner be notified that a fax has been sent to ensure prompt handling of the amendment or communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


ANTHONY GREEN
PRIMARY EXAMINER
ART UNIT 1755

ajg
June 2, 2003